Attorney's Docket No. 5577-115.CX   PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Nguyen et al.   Group: 2178
Serial No.: 09/207,945   Confirmation No.: 7467
Filed: December 9, 1998   Examiner: T. Huynh
For: SYSTEMS, METHODS AND COMPUTER PROGRAM PRODUCTS FOR ASSOCIATING
DYNAMICALLY GENERATED WEB PAGE CONTENT WITH WEB SITE VISITORS

March 12, 2004

Mail Stop Appeal-Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §1.193(b)(1)

Sir:

This Reply Brief is filed to respond to the issues raised by the "Related Appeals and Interferences", "Grouping of Claims" and "Response to Arguments" sections of the Examiner's Answer mailed February 24, 2004. Appellants submit that, for at least the reasons discussed herein and in Appellants' Appeal Brief mailed December 8, 2003, the pending claims are not obvious in view of the cited references. Appellants incorporate each of the arguments and positions in the Appeal Brief in the present Reply Brief as if set forth fully herein. In the interest of brevity, these arguments and positions will not be reproduced below.

I.   Related Appeals and Interferences

The Examiner's Answer appears to contain an editing error in that it states that Appellants' Appeal Brief both does and does not contain a statement identifying the related appeals and interferences. Appellants note that such a statement is in fact contained in the Appeal Brief.

II.   Appellants' Grouping of Claims

The Examiner states that, for purposes of this appeal, all of the pending claims should be treated as standing or falling together because "appellant's brief does not include a statement that

this grouping of claims does not stand or fall together and reasons in support thereof."
(Examiner's Answer at 3). However, the Examiner appears to have overlooked the section titled
"Grouping of Claims" set forth on pages 2-3 of Appellants Appeal Brief. In that section,
Appellants set forth three separate groups of claims that may be considered as standing and
falling together. Appellants further refer the Board to the "Argument" section of the Appeal
Brief for a discussion as to why the Group II and Group III claims are separably patentable from
the Group I claims. This discussion is provided at pages 10-12 of the Appeal Brief. Appellants
respectfully submit that Appellants Grouping of Claims fully complies with 37 C.F.R. §
1.192(c)(7) and, thus, for purposes of this Appeal all three claim groupings should be separately
considered in this appeal.

III.   The Cited Art Does Not Disclose All of the Elements of the Group I Claims

All of the pending claims[1] recite "appending the stored record of the user request with the
unique identifier associated with the content object included within the generated Web page" or a
similarly worded recitation. In the Examiner's Answer, the Examiner claims that Blumenau
discloses this recitation of the pending claims. (*See* Examiner's Answer at 5, arguing that
Blumenau discloses "appending the stored record of the user request with a unique URL
identifier associated with the content object included within the generated web page").
Appellants, however, respectfully submit that Blumenau does not teach or disclose what the
Examiner claims for the following reasons.

A.   Blumenau Does Not "Append" a Content Object Identifier to a Stored Record of a Request for a Web Page

As an initial matter, Blumenau does not disclose **appending** a content object identifier to
a stored record of a request for a Web page in a Web server log. The cited portion of Blumenau

---

[1] Each of the Group II and Group III claims depend from a Group I claim and, hence, the Group
II and Group III claims are patentable over the cited references for the same reasons the Group I
claims are.

discusses a system for monitoring requests for content over the World Wide Web. (Blumenau at Col. 1, line 66 to Col. 2, line 1). In the Blumenau system, a Web server responds to a request from a client computer for a Web page by transferring a file to the client that represents the Web page along with any other files that are necessary to generate the Web page. (Blumenau at Col. 2, lines 20-27 and 63-66). As part of this process, the Web server generates a log file that records "an identification of the file requested" and the "IP (Internet Protocol) address of the client computer." (Blumenau at Col. 2, lines 31-44). Blumenau repeatedly emphasizes (as admitted in the Examiner's Answer) that in cases where a request for a Web page results in the transfer of multiple files, **a separate entry is recorded in the log file for each file that was transferred**. (Blumenau at Col. 2, line 63 to Col. 3, line 3; Examiner's Answer at 17).

As should be clear from the above description, the system discussed in Blumenau includes a log file which, for each file transferred from a server to a client, lists **two items**, namely (i) the IP address of the client and (ii) an identification of the file requested by that client.[2] In contrast, each of the pending claims are directed to methods, systems or computer program products in which a content object identifier is appended to a record of a user request for a web page that is stored in a log file. Thus, the log files of the pending claims include at least **three distinct items**, namely, (i) an identification of the requesting user, (ii) an identification of the web page requested and (iii) an identifier associated with a content object that was included within the generated Web page. The system of Blumenau does not append anything to a stored record of a user request – instead, the log file in Blumenau includes separate records or "transactions" for each and every file transferred. Appellants respectfully submit that Blumenau's failure to teach or disclose this recitation of the claims mandates withdrawal of the pending rejections.

In an effort to overcome the shortcoming of Blumenau, the Examiner argues that providing separate entries in the log file for the "other files" that are transferred to generate a

---

[2] Blumenau states that additional information, such as a browser type or a time stamp, may also be included in the log file. Blumenau, however, does not disclose appending to an entry in the log file an identifier of a content object that is included within a requested Web page.

specific Web page constitutes "appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page." (*See* Examiner's Answer at 17). However, as is well known to those of skill in the art, **adding** new records of transactions to a database file is very different from **appending** information to an existing record stored in the file. The Examiner's argument, therefore, only serves to highlight Blumenau's failure to teach or disclose the "appending" recitation of the pending claims. When information is appended to a stored record in a file or database, it, by definition, is logically related to the remaining information contained within the record. The same is not true when additional information is added to the file or database as a separate transaction or record. As the Blumenau reference itself notes, this distinction can be very important with respect to how the stored information can be used. For example, Blumenau states that problems arise when attempting to use the system described therein to monitor the display of Web pages because the log file may include many more entries than there were user requests for Web pages. (*See* Blumenau at Col. 3, lines 1-15). However, according to the teachings of embodiments of the present invention such problems may be avoided by appending the unique identifier associated with the content object directly to the stored record of the request for the Web page.

B.   Blumenau Does Not Store "Requests for Web Pages"

Blumenau likewise fails to disclose the recitation of the pending claims of "appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page" because the log file in Blumenau stores "an identification of the file requested" as opposed to a "record of the user request [for a Web page]." This difference between the claimed invention and the system of Blumenau is made clear by Blumenau's discussion of "under-counting" problems that may occur when the system of Blumenau is used to count how many times a Web page was viewed by clients of the Web server. As explained in Blumenau, such undercounting can occur because "once transferred to a client computer at a content display site, the files necessary to generate a Web page can be stored ('cached') on that client computer." (Blumenau at Col. 3, lines 27-29). As a result, the client

(user) can view the Web page additional times "without causing the client computer to make another request to the content provider server computer." (Blumenau at Col. 3, lines 29-32). Thus, with the system of Blumenau, "the [client] can view the Web page without causing transactions to be added to the log file, resulting in undercounting of the number of Web page hits." (Blumenau at Col. 3, lines 32-35).

As the above-recited quotations from Blumenau make clear, the log file in Blumenau stores a list of **the files that are transferred** to clients of a server as opposed to a listing of the Web pages that users requested from the server. These two listings are not the same, which is precisely why the system of Blumenau experiences both the under-counting and the over-counting problems that are discussed at Column 3 of Blumenau. Thus, Blumenau's failure to disclose storing records of user requests for Web pages provides an independent basis for withdrawal of the rejections of the pending claims.

IV. The Examiner Has Failed to Identify Motivation to Combine Blumenau and Wodarz in the Manner Suggested

The Examiner argues that a person of skill in the art would have been motivated to combine Blumenau and Wodarz in the manner suggested because Wodarz allegedly "suggests" selecting the advertisements that are to be displayed to a user based on a stored record of the content objects that the user in question had previously requested. (*See* Examiner's Answer at 18). In support of this argument, the Examiner points to the following two statements from Wodarz:

(1)   The advertisement that is to be displayed may be selected based on a least recently viewed algorithm and/or based on the maximum number of times that an advertisement has been viewed in a specific time period; and

(2)   The system tracks the number of times an advertisement has been viewed.

(Examiner's Answer at 18). Appellants respectfully submit that these statements from Wodarz simply do not suggest selecting the advertisement that is be to displayed based on information

gleaned from a user's prior selection of advertisements. In fact, Wodarz's suggested use of "least recently viewed" and "maximum number of time" algorithms teach away from combining Blumenau and Wodarz in the manner suggested, as these algorithms are completely independent of the user's preferences and do not take into consideration the user's previous Web viewing selections in any way. The fact that the system of Wodarz tracks the number of times that an · advertisement has been viewed is equally irrelevant, as counting how many times an advertisement is viewed (by any client) provides no information regarding any specific client's preferences and in no way suggests using prior viewing choices of a specific client to select which advertisements to display. Thus, as the Examiner has failed to show that a skilled artisan would have been motivated to combine the Blumenau and Wodarz references in the manner suggested in the pending rejections, each of the rejections should be withdrawn.

The Examiner further argues that even if the Wodarz and Blumenau references do not provide the requisite motivation to combine, such motivation is provided by Shaw. (*See* Examiner's Answer at 18-19). In support of this argument, the Examiner cites to Col. 3, lines 40-58 of Shaw as teaching that "information in a log file is used to determine appropriate advertisement[s] for users." (*Id.*). However, the cited portion of Shaw discusses an "event log file" that contains information regarding, for example, what advertisements had previously been shown and the number of remaining exposures for an advertisement. Once again, this is very different from storing and using information regarding a user's previous viewing choices to select what content objects are displayed to the user in the future. While the cited references suggest various ways of deciding which advertisements to display, none of them do so based on the user's previous web-viewing choices. Appellants respectfully submit that Shaw likewise fails to provide the requisite motivation to take the log file from Blumenau and use it as the basis for selecting the advertisements that are displayed in Wodarz.

V.   The Examiner Has Failed to Identify Motivation to Combine Wodarz and Monier in the Manner Suggested

The Examiner further argues in the Examiner's Answer that a skilled artisan would have been motivated to combine Wodarz and Monier because both references "teach the need of having unique identifiers to objects sent to client content displays." (Examiner's Answer at 20). There are many ways, however, to provide a series of unique identifiers, including, for example, numbering the items sequentially, labeling them alphabetically, giving them unique names, etc., and nothing in the cited references suggests that the hashing function discussed in Monier should be used to generate the "unique identifiers" labeled A-D in Table 1 of Wodarz in lieu of the numerous other available methods. In fact, as discussed in Appellants' prior brief, a skilled artisan would **not** have been motivated to use a hashing function in the system of Wodarz given the relatively small number of advertisements that would be used in that system. While Appellants do agree with the Examiner's that the listing of four advertisements in Table 1 is only an example of the Wodarz system, that is beside the point, as the question is whether the cited references provide some motivation that would lead the skilled artisan to choose the hashing function of Monier in lieu of the numerous other available methods. The Examiner has failed to identify any such motivation, which Appellants respectfully submit provides yet another basis for withdrawal of the pending rejections.

VI. The Group II Claims are Independently Patentable Over the Cited Art

The Examiner argues that the rejections of the Group II claims should be sustained because the combination of Wodarz and Blumenau "clearly suggest" the step of "analyzing a plurality of stored user request records to determine [the] Web content preferences of a user." (Examiner's Answer at 21). The Examiner goes on to state that this "suggestion" arises from (1) Wodarz's disclosure of other methods of selecting what advertisement to display (*e.g.,* analysis of a user's physical characteristics) and (2) the inclusion in the log file of Blumenau information regarding which files were previously transferred to the user. Appellants respectfully submit that the cited portions of Wodarz and Blumenau do not "clearly suggest" what the Examiner claims.

Specifically, Wodarz discloses a wide variety of mechanisms that can be used to decide what advertisements are displayed to the various users. However, nowhere does Wodarz teach

or suggest that an analysis of a user's previous Web-viewing record is such a mechanism. Blumenau, discloses maintaining a log file at the server that identifies the files that were transferred to each client. This log file is compiled to provide a mechanism for counting the number of requests for Web pages that were received by the server. (Blumenau at Col. 2, lines 53-58). Once again, there is no teaching or suggestion in Blumenau that the log file could or should be analyzed "to determine the Web content preferences of a user." Thus, neither Blumenau nor Wodarz teaches or suggests the recitation added in each of the Group II claims. This alone mandates withdrawal of the pending rejections. The rejections likewise should be overturned because the Examiner has failed to identify any reason that a skilled artisan would have been motivated to take the log file from Blumenau and use it in the system of Wodarz as the method used to select the advertisements that are displayed. This provides a second, independent reason for withdrawal of the rejections of the Group II claims.

VII.   The Group III Claims are Independently Patentable Over the Cited Art

The Examiner also argues that the rejections of the Group III claims should be sustained because the combination of Wodarz and Blumenau allegedly discloses "determining a length of time the user views the generated Web page using time stamps within the stored record." Specifically, the Examiner argues that it would have been obvious to select content based on the length of time a user views certain Web pages because the system in Wodarz uses "many things to do with [a] time stamp" and because it would be "easy to do." However, none of the cited examples from Wodarz even remotely suggests determining and including within the stored record the length of time a user views the generated Web page as recited in the Group III claims. In fact, the length of time a user views an advertisement is not information that is necessary for implementing any of algorithms discussed in Wodarz (including the three mentioned by the Examiner) for deciding which advertisement to display. Thus, Appellants submit that the Examiner has failed to identify any reason why a skilled artisan would have been motivated to incorporate the time stamp from Blumenau into the system of Wodarz.

VIII.   Conclusion

In light of the above discussion, Appellants submit that each of the pending claims is patentable over the cited references and, therefore, request reversal of the rejections of Claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57.
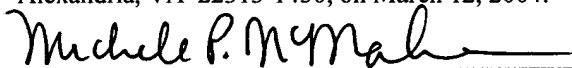
Respectfully submitted,

D. Randal Ayers
Registration No. 40,493

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal-Brief Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 12, 2004.

Michele P. McMahan
Date of Signature: March 12, 2004